

03/10/2006 FRI 14:35 FAX 12489888363 Carlson, Gaskey & Olds

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OT-4812

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: O'Donnell, et al.

Serial No.: 09/921,803

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Filed: 08/03/2001

Group Art Unit: 3652

Examiner: Tran, Thuy Van

For: ELEVATOR BELT ASSEMBLY WITH WAXLESS COATING

REQUEST FOR RECONSIDERATION

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is responsive to the Office Action mailed on January 12, 2006. Applicant respectfully requests reconsideration.

The Examiner's conclusion regarding the *Scudder* reference is incorrect. In column 1, the *Scudder* reference clearly teaches that the semi-plastic state of the polyurethane is what makes it "sticky." That does not in any way suggest that the polyurethane does not contain a wax. Therefore, it cannot "be reasonably interpreted that the polyurethane in *Scudder* does not include wax." The addition of an oily substance in the *Scudder* reference does not suggest that the polyurethane itself does not include wax and stretching the teachings of the reference in that way is not reasonable.

Applicant respectfully disagrees with the Examiner's conclusions regarding the proposed combination of the DE '654 and *Scudder* references. The Examiner's

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suggested motivation for combining them does not come from the references. In fact, the German patent seems to suggest no such need and seems to minimize any importance of the plastic belt body of that reference (except for forming teeth on the outside) and does not have any indication of any time consuming or uncertain results for which *Scudder's* teachings would provide any benefit.

Additionally, there would be no benefit to making the combination even if it were possible to interpret *Scudder* as teaching a waxless polyurethane. The lifting device of the German reference includes a piston 2,3 that moves the load from beneath the belt. That arrangement does not present any traction considerations for which a waxless polyurethane might prove useful. In other words, adding a waxless polyurethane to the German reference provides no benefit. Where there is no benefit to a proposed combination, there is no motivation for making it and no *prima facie* case of obviousness.

This application is in condition for allowance.

Respectfully submitted,

CARLSON, GASKEY & OLDS

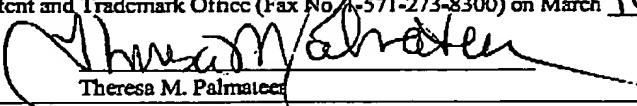
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Dated: March 16, 2006

CERTIFICATE OF FACSIMILE

I hereby certify that this Request for Reconsideration, relative to Application Serial No. 09/921,803, is being facsimile transmitted to the Patent and Trademark Office (Fax No. 703-571-273-8300) on March 10, 2006.


Theresa M. Palmateer